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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/227,593	01/08/1999	MICHAEL E. BESSE	730.010US1	8016

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EXAMINER

TOOMER, CEPHIA D

ART UNIT	PAPER NUMBER
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1714

27

DATE MAILED: 08/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/227,593

Applicant(s)

BESSE ET AL.

Examiner

Cephia D. Toomer

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1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 31-40, 42-79, 81-104 and 106-108 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-36, 38-40, 42, 45-60, 63-67, 70-75, 77-79, 81, 84-99, 102-104 and 106 is/are rejected.
- 7) ☒ Claim(s) 37, 43-44, 61-62, 68-69, 76, 82-83, 100-101, 107-108 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION*****Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 25, 2002 has been entered.

This office action is in response to the amendment filed March 25, 2002 in which claims 41, 80 and 105 were amended and claims 31, 40, 44-45, 69-70, 76-77, 79, 81, 83-84, 100-102, 104, 106 and 108 were amended.

2. The rejection of the claims under 35 USC 112, first paragraph, is withdrawn in view of the amendments to the claims.

3. The rejection of the claims under 35 USC 112, second paragraph, is withdrawn in view of the amendments to the claims.

4. The rejection of the claims under 35 USC 103(a) over Despo in view of Liu is withdrawn in view of the amendments to the claims.

5. Claim 65 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the C<sub>12</sub> -C<sub>15</sub> linear alcohols with 7 ethylene oxide units, does not reasonably provide enablement for all alkoxyated alcohols. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in

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scope with these claims. There is no mention in the specification of alkoxyated alcohols except for the very specific compound that appears in the examples.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims rejected under 35 U.S.C. 103(a) as being unpatentable over Person-Hei in view of Liu.

Claims 31-36, 38-40, 42, 45-60, 63-67, 70-75, 77-79, 81, 84-99, 102-104, and 106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Person Hei (US 5,723,418) in view of Liu (US 5,244,589).

Person Hei teaches a conveyor lubricant composition comprising water, corrosion inhibitors, such as alkyl and aryl alkoxyated phosphates, and antimicrobial agents/surfactants, such as quaternary ammonium chloride and surfactants such as nonionic alkoxyated alcohols (see abstract; col. 2, line 50-67; col. 4, lines 1-10; col. 5, lines 10-25). The corrosion inhibitors are present in an amount from 0.05 to 25% (see col. 4, lines 23-28); and the surfactants are present in an amount from 0.01 to 50 wt % (see col. 5, lines 35-40). Person Hei teaches that the cationic surfactants have antimicrobial properties (see col. 5, lines 18-25). The pH of the solution is between 5 and 10 (see col. 4, lines 31-33). Person Hei teaches the limitations of the claims other than the differences that are discussed below.

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In the first aspect, Person Hei differs from the claims in that she does not specifically teach that the quaternary compounds are linear. However, Liu teaches this difference (see col. 5, line 47 through col. 6, lines 1-5).

It would have been obvious to one of ordinary skill in the art to have substituted linear quaternary compounds for the aryl quaternary compounds of Person Hei because Liu teaches that these compounds are equivalent for the purpose of imparting antimicrobial properties to conveyor lubricants.

In the second aspect, Person Hei differs from the claims in that she does not specifically teach the ratio of phosphate ester/quaternary ammonium compound (claims 32, 50, 52-54, 56-58, 71, 89, 91-93, 95-97). However, no unobviousness is seen in this difference because Person Hei teaches that the phosphates are present in the composition in an amount from 0.05-25% and that the quaternary ammonium compounds are present in an amount from 0.1-10% and it is well settled that where the general conditions of the claims are disclosed in the prior art it is not inventive to determine the optimum proportions through routine experimentation.

In the third aspect, Person Hei differs from the claims in that she does not specifically teach that the composition of her invention contains a chelating agent (sequestrant) (claims 38, 39, 44, 63, 64, 77-78, 102-103, and 108). However, Liu teaches this difference (see col. 7, line 60 through col. 8, lines 1-7).

It would have been obvious to one of ordinary skill in the art to have included a chelating agent in the composition because Liu teaches that these compounds chelate

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hardness components in the service water into which the conveyor lubricant is dispensed.

Person Hei fails to disclose a composition wherein the alkyl and aryl alkoxyated phosphate esters are both present or a composition wherein the cationic surfactant (quaternary compound) and the nonionic surfactant (alkoxylate alcohols) are both present (claims 40, 42-45, 65-69, 79, 81-84, 104 and 106-108). However, it is prima facie obvious to combine two components each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. In re Kerkhoven, 205 USPQ 1069 (CCPA 1980).

8. Applicant's arguments filed March 25, 2002 have been fully considered but they are not persuasive.

Applicant states that the combination of components of the present invention provides increased lubricity and advantageous properties with respect to sedimentation, precipitation, cloudiness and deposits. Applicant argues that Person Hei did not recognize, disclose or suggest these advantages.

Applicant's data have been considered and are not deemed to constitute unexpected results. Applicant's base claims are devoid of proportions whereas the data exemplifies these components in very specific proportions. Furthermore, the broad claims read on far more compounds than are exemplified. It cannot be ascertained from the data if the broadly claimed range of compounds provides unexpected results.

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Applicant argues that Person Hei fails to suggest using the quaternary ammonium compounds as antimicrobial agents.

The examiner respectfully disagrees. At col. 5, lines 18-21, Person Hei teaches that the cationic surfactants may also function as an additional antimicrobial and that typical examples of these compounds include quaternary ammonium chloride surfactants.

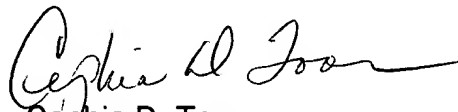
9. Claims 37, 43, 44, 61-62, 68-69, 76, 82-83, 100-101, and 107-108 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art fails to teach the addition of an alkali metal hydroxide, the specific aryl alkoxylated phosphate or the combination of additional components.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 703-308-2509. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9310 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
Cephia D. Toomer  
Primary Examiner  
Art Unit 1714

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August 3, 2002